

Docket Number: 10981981-4
Application No. 10/016,629
Amendment B

REMARKS/ARGUMENTS

Claims 1, 11, 12, and 21 - 23 are in the application. Claims 24 -- 27 have been withdrawn. Reconsideration is respectfully requested.

Rejections under Section 102

Claims 1, 11, 12, and 22 were rejected as anticipated by Brault.

As respects claims 1 and 22, the grounds for rejection (Paragraph 5 of the Detailed Action) reassert the grounds asserted in the previous office action. Specifically, among other things, the rejection grounds state that the Brault recording element shown in Fig. 3B discloses "*a transparent (therefore translucent) image receiving layer (16).*"

In addressing this rejection in the previous response (Amendment A, filed December 19, 2003), applicant disagreed with the Examiner's reading of Brault's disclosure of a transparent image-receiving layer as expressly or inherently teaching a translucent layer.

In the Response to Arguments portion of the current office action, the Examiner states that the claimed term "translucent" is synonymous with "transparent," and a dictionary definition is included to show such usage of the term "translucent."

Applicant had asserted (and still does) that the claim term "translucent" could not be reasonably interpreted, *consistent with the specification*, as meaning "transparent."

In this regard, applicant submits that while claim terms are to be given their broadest reasonable interpretation during examination, this interpretation must be consistent with the specification. *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). As noted in applicant's last paper, independent claim 1 recites a translucent ink-receiving coating, and claim 22 recites translucent ink-receiving material. The specification (page 9, lines 21 - 26) discusses such translucent material and its function, as follows:

"It is noteworthy here that best results are obtained when the sol-gel of the ink-receiving layer 24 is prepared to be translucent or "milky" in appearance, thereby to effectively hide any adhesive that may appear on non-printed portions of the image. This translucence in the sol-gel can be accomplished by blending titania into the sol-gel mixture before it is applied as the ink-receiving coating 24."

Thus, the claimed ink-receiving coating or material 24 (which is applied to a transparent sheet 30 of media) is milky in appearance for hiding any adhesive that may appear on the backing material to which the coated sheet is bonded.

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Applicant submits that the claim term "translucent" should be interpreted as *transmitting light but causing sufficient diffusion to prevent perception of an adhesive*. This, applicant believes, is how one of ordinary skill in the art would construe that term after reading the present specification. Moreover, this is the correct approach to claim interpretation, as set forth in the MPEP¹:

"The PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant's specification." (Emphasis added).

Looking at this issue another way, and if one assumes for the sake of argument that the common usage of the claim term "translucent" is synonymous with "transparent," it is submitted that applicant's efforts to ascribe a particular meaning to the term "translucent" is a long-accepted method for applicants to express the metes and bounds of a claimed invention. Specifically, an applicant may act as its own lexicographer, provided, as here, that *"any special meaning assigned to a term 'must be sufficiently clear in the specification [so] that any departure from common usage would be so understood by a person of experience in the field of the invention.'"* MPEP § 211.01, citing *Multiform Desiccants Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998).

In view of the foregoing, applicant submits that the interpretation of the term "translucent" as set forth in the office action does not take into account applicant's efforts in the specification to have that claim term construed as discussed above.

Once the claim term "translucent" is properly construed as described above, applicant submits that it is quite clear that Brault's disclosure of a transparent image-receiving layer neither expressly nor inherently teaches such a translucent layer and, therefore, the rejection of claims 1 and 22, and the claims depending therefrom, should be withdrawn.

¹ MPEP § 211.1, citing *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997).

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Conclusion

In view of the foregoing, applicant believes that all of the currently pending claims are in condition for allowance, and an early notification to that effect is respectfully requested. If the Examiner has any questions, he is invited to contact applicant's attorney at the below-listed telephone number.

Respectfully submitted,
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